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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,089	12/02/2003	Fred G. Devlin III	4888-102.1 US	3425

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EXAMINER

NGUYEN, JIMMY T

ART UNIT PAPER NUMBER

3725

DATE MAILED: 06/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/726,089

Applicant(s)

DEVLIN ET AL.

Examiner

Jimmy T Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-24 is/are pending in the application.
- 4a) Of the above claim(s) 20-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/2/03
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

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Election/Restrictions

Applicant's election with traverse of Group I (claims 8-19) in Paper filed on May 24, 2004 is acknowledged. The traversal is on the ground(s) that a search of the system of Group I would uncover the method of Group II. This is not found persuasive because the apparatus (Group I) as claimed does not require a collecting (claim 20) and a stacking sequence (claim 24) as claimed in the method (Group II). Because the inventions are distinct for the reasons given above and accordingly the required searches differ, thus the restriction is proper.

The requirement is still deemed proper and is therefore made FINAL.

An action on the merits of the elected claims 8-19 follows.

Specification

The disclosure is objected to because of the following informalities:

On page 1, line 5, the following --- now US Patent number 6,715,407 --- should be added after the year "2002".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 10-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not

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described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 10, lines 2-3, the specification does not support "a main piston cylinder coupled to the first crushing plate and the second crushing plate", the specification discloses the main piston cylinder (11) coupled only to one crushing plate (12) (see fig. 1).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 8, it is unclear what the structural interrelationship between "means for compacting" and "means for maintaining".

Regarding claim 13, it is unclear what the structural interrelationship between "means for pinching" and "means for inserting".

Regarding claim 17, it is unclear what the structural interrelationship between "means for marking" and other elements as claimed in the preceding claim 8.

Regarding claim 16, line 2, there is no antecedent basis for "said one or more protrusions" in the claim as it is depended upon claim 15. For the purpose of examination, claim 16 is treated as it is depended upon claim 14. Additionally, it is unclear whether "said one or more protrusions" is/are the protrusion(s) of the first crushing plate or the second crushing plate.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 8-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Parker (US 6,539,850). Parker discloses a system for recycling a tire comprising: means for compacting the tire (see fig. 3), and means for maintaining (56) the tire in a compacted form (fig. 4), wherein in the compacted form, a cubic volume of the tire is reduced by at least fifty percent (figs. 2 and 3).

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 8-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Nordberg (US 5,347,919).

Regarding claims 8 and 9, Nordberg discloses a system for recycling a tire comprising: means for compacting the tire (see figs. 2-3), and means for maintaining (72) the tire in a compacted form (fig. 4), wherein in the compacted form, a cubic volume of the tire is reduced by at least fifty percent (fig. 3). As to the system is using for recycling an individual tire, it is inherent that Nordberg's system is capable of recycling an individual tire (see the structural arrangements of the system in figs. 2 and 3).

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Regarding claims 10 and 11, Nordberg discloses a hydraulic piston cylinder (25) coupled to a first crushing plate (40), and the cylinder moved the first crushing plate toward and away from a second crushing plate (30).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nordberg, as applied to claim 8 above, in view of Phillips (US 5,718,166). Nordberg discloses the invention substantially as claimed with the exception of the specific means for maintaining the tire in the compacted form as claimed. While the claims call for punching/inserting, Nordberg discloses the use of bands (40) for maintaining the tire in the compacted form. However, the patent to Smith, teaches that it is old and well known in the tire compacting/binding art to provide a means for maintaining the tire in a compacted form which comprises pinching the compacted tire at one or more locations by a spearheaded plunger cylinder (56, 88), and inserting (112) a coupling element (116) at the pinched location. Therefore, it would have been obvious matter of choice to substitute Phillip's method of maintaining the tire in Nordberg's disclosure as such would be a mere substitution of mechanical expedients.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nordberg, as applied to claim 8 above, in view of Smith et al. (US 4,729,301 – hereinafter “Smith”).

Nordberg discloses the invention substantially as claimed with the exception of a sensing means as claimed. However, the patent to Smith, teaches that it is old and well known in the compacting/binding art to provide a sensing means (23a, 24a) for sensing the movement of a first crushing plate (30) toward/away from a second crushing plate (fig. 2), wherein the sensing means activates a means for maintaining material (3) when a specified sensing output is received (col. 4, lines 24-31). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide Nordberg's system with a sensor, as taught by Smith, in order to activate the means for maintaining the tire, when a specified sensing output is received. As to the sensing means being a proximity sensor, it would have been obvious matter of choice to select a proximity sensor from all of the available sensing devices, since it is within the general skill of a worker to select a known sensing device on the basis of suitability for the intended use as a matter of obvious design choice.

Claims 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nordberg, as applied to claim 8 above, in view of Cristofano (US 5, 244,611). Nordberg discloses the invention substantially as claimed with the exception of marking the tire with an identifier that represents identification of a tire generator. However, the patent to Cristofano teaches that it is old and well known in the tire processing art to mark a tire (2) with an identifier (23) that represents identification of a tire generator/machine (col. 2, lines 41-43). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide Nordberg's system with an identifier as taught by Cristofano in order to

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identifying the "origin" of the tire (col. 2, line 46). As to the identifier is a sequence of letters, numbers, or symbol; Cristofano teaches an identifier as a symbol, (col. 2, lines 41-44).

Allowable Subject Matter

Claim 14 and 16 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claim.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art listed on the attached PTO 892 are cited to show relevant tire recycling system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jimmy T Nguyen whose telephone number is (703) 305-5304. The examiner can normally be reached on Mon-Thur 8:00am - 6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allen Ostrager can be reached on (703) 308-3136. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JTNguyen
June 04, 2004



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